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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,483	02/17/2004	Jay Philip Leighton	109537/269021	1538
826	7590	12/05/2005	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			BEFUMO, JENNA LEIGH	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/780,483

Applicant(s)

LEIGHTON ET AL.

Examiner

Jenna-Leigh Befumo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 35-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 – 35 and 41, drawn to a composite fabric, classified in class 442, subclass 104.
  - II. Claims 36 – 40, drawn to a method of making a composite fabric, classified in class 83, subclass various.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by weaving the fabric the desired width of the finished composite sheet and not cutting a wider composite sheet into the desired width.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Jason Cooper on October 5, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 – 35 and 41. Affirmation of this election must be made by applicant in replying to this Office action. Claims 36 – 40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Objections***

6. Claim 16 is objected to because of the following informalities: the claim is not a complete sentence since it lacks a period at the end of the sentence. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 – 6, 8 – 18, 20 – 31, 33, 34, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Dutt (6,174,825).

Dutt discloses a resin-impregnated endless belt comprising a base fabric having machine direction (MD) and cross-machine direction (CD) elements and a coating of a polymeric resin (abstract). The MD elements and CD elements are spaced apart from one another by a distance in the range of 0.0625 inch to 0.5 inch (column 4, lines 10 – 20). The base fabric can be a leno woven fabric where the warp yarns are woven in pairs with the spacing between the pairs of warp yarns (column 6, lines 57 – 65). The fabric can also be an open woven fabric where the

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MD and CD yarns grouped together in groups of three with the groups having the desired spacing between them (column 8, line 65 – column 9, line 12). The MD and CD yarns can be multifilament yarns, monofilament yarns, or plied monofilament yarns (column 9, lines 13 – 25). The base fabric is impregnated with a polymeric resin such that the entire fabric is embedded within the resin layer, as shown in Figure 15 (column 12, lines 10 – 30).

Thus, Dutt discloses an impregnated fabric having sections along the length of the fabric with no warp yarns which are at least 0.3 inch wide. Further, the sections with the warp yarns can include at least a pair of leno warp yarns, or the section comprising the warp yarns can include multiple pairs of leno warp yarns, while the spacing between those sections is at least 0.3 inch wide. Finally, the fabric is woven to be the width of the machine on which it is impregnated with the polymeric resin (column 10, lines 48 – 55). Thus, the warp yarns will not be exposed at the edges of the polymeric sheet. Therefore, claims 1 – 6, 8 – 18, 20 – 31, 33, 34, and 41 are anticipated.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 19, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutt.

The features of Dutt have been set forth above. Dutt discloses that the fabric is woven so that it will fit on the mandrel which holds the fabric in place while the fabric is coated and impregnated with a polymeric sheet as shown in Figure 14 (column 10, lines 40 – 65). Thus, the

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fabric is not wider than the polymeric sheet. However, while Dutt discloses that the woven fabric is open with spacing of between 0.0625 inch to 0.5 inch between the groups of yarns to allow for the polymer to completely impregnate the woven fabric, Dutt fails to teach that the warp yarns are at least 0.15 inch from the edge of the polymeric sheet. This would suggest to one of ordinary skill in the art that the yarns should be spaced away from the edge of the polymeric sheet so that the fabric is completely enclosed by the polymeric sheet. Thus, one of ordinary skill in the art would be motivated to make fabric slightly narrower than the desired width of the finished belt so that the fabric is completely embedded within the polymeric coating. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the warp yarns at least 0.15 inch from the edge of the polymeric sheet, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). Thus, claims 7, 19, and 32 are rejected.

### ***Conclusion***

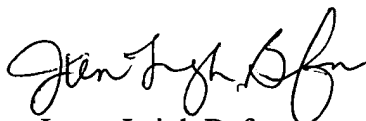
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are drawn to coated or impregnated woven fabrics, but do not teach the claimed spacing between the groups of warp yarns: McCabe et al. (3,941,162); Spaar (3,973,670); and Stevenson et al. (6,056,479). Further, Haneburger (2004/0180591 A1) discloses a similar coated woven fabric, but does not qualify as prior art since it was filed after the priority date of the present application.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jenna-Leigh Befumo  
November 21, 2005